

REMARKS**Summary of the Office Action**

Claims 1 and 2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out distinctly claim the subject matter which applicant regards as the invention.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,560,529 to *Udagawa et al.* ("*Udagawa*").

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa*.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa* in view of German Patent No. DE 84519 ("*DE '519*") or U.S. Patent No. 4,770,334 to *Hoshi et al.* ("*Hoshi*").

Claim 14 is allowed.

Summary of the Response to the Office Action

Claims 3-13 have been withdrawn as the result of the restriction requirement. Claim 1-2 and 14 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1 and 2 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants respectfully traverse the rejection for the following reasons.

The Office Action alleges that the subsequent amendments to claims 1 and 2 have impermissibly changed their scope. After analysis of the Office Action, Applicants maintain that

claims 1 and 2 are not indefinite because they are drawn to a stapling apparatus having the special technical feature of a toothed staple feed roller. Pending claims 1 and 2 are basically the same claims as those restricted by the Examiner on April 15, 2008. The argument that subsequent amendments to claims 1 and 2 have impermissibly changed their scope is unfounded because no new elements have been added to claims 1 and 2, rather there has been only slight clarification to the elements previously recited. These slight changes have not radically changed the scope of claims 1 and 2 as alleged by the Office Action. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Rejections Under 35 U.S.C. § 102(b)

Claim 1 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Udagawa*.

Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Udagawa* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Independent claim 1 recites, in part, "wherein said peripheral face of the rolled staple is an outer circumference of a wound portion of the rolled staple where the staples are wound, and the feeding roller is in contact with the outer circumference of the wound portion." *Udagawa* fails to teach or suggest at least these features of claim 1.

The Office Action argues that the staple feed roller 43 of *Udagawa* corresponds to the claimed "feeding roller" and that the Fig. 9 discloses the claimed rolled staple. However,

Applicants respectfully submit that the staple feed roller 43 as disclosed in Fig. 8 is a roller that is in contact with a flat portion of a staple sheet, and not "a wound portion" as recited in claim 1. In Fig. 9, the roller 43 is not even disclosed. That is, neither Fig. 8 nor Fig. 9 discloses that "the feeding roller is in contact with the outer circumference of the wound portion," as recited in claim 1.

Now the Office Action asserts that the particulars of the contact location should not be given any patentable weight since in the previous amendments only a stapler is claimed, not a combination of a stapler and a cartridge, per se. Applicants strongly disagree. The claimed stapling apparatus includes, in part, a rolled staple composed of a large number of straight staples linearly coupled to form a roll shape. Thus, cartridge components and stapler components have always been recited in claim 1 and are components of the stapling apparatus and should not be discounted by the Office Action. The particulars of the contact location when given their proper patentable weight, makes clear that *Udagawa* fails to teach or suggest each and every feature of claim 1. Thus, the rejection of claim 1 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Udagawa* does not teach or suggest each feature of independent claim 1.

The Rejections Under 35 U.S.C. § 103(a)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa*.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa* in view of *DE'519* or *Hoshi*. Applicants respectfully traverse the rejection for at least the following reasons.

The Office Action has taken Official Notice that "the feeding roller is in contact with the outer circumference of the wound portion," of the rolled staple. In this Non-Final Office Action, official notice is inappropriate. See M.P.E.P. § 2144.03:

"Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))."

It is not appropriate to rely solely on alleged "common knowledge" in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. Thus, Applicants respectfully submit that the Examiner either find prior art showing the features above-mentioned or withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Udagawa*.

Applicants also respectfully submit that the Office Action has not established that *Udagawa* in view of *DE'519* or *Hoshi* teaches each and every feature of Applicants' claim 2 and

that the rejections under 35 U.S.C. § 103(a) should be withdrawn.

Independent claim 1 recites, in part, “wherein said peripheral face of the rolled staple is an outer circumference of a wound portion of the rolled staple where the staples are wound, and the feeding roller is in contact with the outer circumference of the wound portion.” As demonstrated above, *Udagawa* fails to teach or suggest at least these features of claim 1. Both *DE'519* and *Hoshi* are relied upon only for a teaching of “teeth” for a feeding roller. Therefore, both *DE'519* and *Hoshi* do not make up for the above-mentioned deficiencies of *Udagawa*. Thus, the features of claim 1 are not obvious over the cited art.

Additionally, Applicants respectfully submit that dependent claim 2 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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